

Remarks

Claims 1-6, 8, 12-16, 19-22 and 24-28 are pending.

Priority

The Office Action denies priority benefit of the U.S. provisional patent application serial no. 60/458,847 filed on March 28, 2003 for claims 1-6, 8, 12-16, 19-22 and 24-28. While Applicants continue to disagree with the Examiner for the reasons provided in the Amendment filed on January 12, 2010, to expedite prosecution Applicants will not be relying on the filing date of the U.S. provisional patent application serial no. 60/458,847 to overcome the cited references.

Summary of Objections and Rejections

The Office Action set forth the following objections and rejections:

claim 3 stands objected to due to an informality;

claims 1-3, 5-6, 8, 12-16, 21-22 and 24-28 stand rejected under 35 U.S.C. §102(a), as being anticipated by Hepp et al, *Light-Emitting Field-Effect Transistor Based on a Tetracene Thin Film*, Physical Review Letters, Vol. 91, No. 15, pp. 157406-1 through 157406-4 (from hereon, Hepp);

claims 4, 19 and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hepp in view of US Patent No. 6,828,583 (from hereon, Heeger);

claims 1-6, 8, 15, 16, 19-22 and 24-28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Heeger in view of US Patent No. 5,596,208 (from hereon, Dodabalapur) and in view of WO 03071608 (from hereon, Hiroshi);

claim 12 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Heeger in view of Dodabalapur, in view of Hiroshi and in view of Rogers et

al, Low-Voltage 0.1 micron Organic Transistors and Complementary Inverter Circuits Fabricated With a Low-Cost Form of Near-Field Photolithography, Appl. Phys. Lett, Vol. 75, No. 7, 1999 (from hereon, Rogers); and

claims 13 and 14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Heeger in view of Dodabalapur, in view of Hiroshi and in view of US Patent Application Publication No. 2003/0122120 (from hereon, Brazis).

Claim Objection

Claim 3 stands objected to due to a minor typographical error.

Applicants have hereby amended claim 3 to correct this minor typographical error. Accordingly, the objection with respect to this claim has been overcome and should be withdrawn.

35 U.S.C. §102(a) rejection

Hepp

Claims 1-3, 5-6, 8, 12-16, 21-22 and 24-28 stand rejected under 35 U.S.C. §102(a) as being anticipated by Hepp. Applicants respectfully traverse the rejection.

Applicants have hereby concurrently filed a Declaration under 37 C.F.R. §1.131 by Mr. Michele Muccini, one of the inventors of the present patent application (from hereon, "the Muccini Declaration") which "swears behind" Hepp, Heeger and Hiroshi.

As the Muccini Declaration states, the presently claimed invention was conceived with due diligence to the actual reduction to practice by as early as February 3, 2003. See, Muccini Declaration, §§ 5-25. The Muccini Declaration further explains that the instant patent application is a result of work by several research groups based in various European countries and working on a common research project in January-February, 2003. At the Steering Committee meeting held on February 3, 2003, one of the research groups presented a scientific

report which later became the basis of both the provisional application (filed on March 28, 2003) and the Hepp reference (published October 10, 2003). All of the authors of the scientific report are named as co-inventors in the instant patent application. See, Muccini Declaration, §§ 10-12. A copy of the report signed by the participants at the meeting is provided as Exhibit B to the Muccini Declaration. The scientific report describes in detail the invention, and in particular, the features of claim 1 and dependent claims. See, Muccini Declaration, §§ 13-15. Further, the scientific report provides evidence that the invention was actually and diligently reduced to practice See, Muccini Declaration, § 24.

Thus, the Muccini Declaration conclusively proves that the invention was conceived with due diligence to the actual reduction to practice by February 3, 2003 which is an earlier date than the publication date of the Hepp reference on October 10, 2003.

Therefore, it is believed that Applicants have disqualified Hepp as a 35 U.S.C. §102 (a) reference. Accordingly, it is respectfully submitted that the rejection has been overcome and should be withdrawn.

35 U.S.C. §103(a) rejections

Hepp in view of Heeger

Claims 4, 19 and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hepp in view of Heeger. Applicants respectfully traverse the rejection.

As Applicants have explained in the section of these Remarks dealing with the 35 U.S.C. §102(a) rejection, the invention was conceived with due diligence to the actual reduction to practice by February 3, 2003. Hepp was published on October 10, 2003. The earliest effective date of Heeger is March 12, 2003. Because the invention was conceived with due diligence to the actual reduction to practice before the effective dates of Hepp and Heeger, these references are

disqualified.

Therefore, it is respectfully submitted that the rejection has been overcome and should be withdrawn.

Heeger in view of Dodabalapur and in view of Hiroshi

Claims 1-6, 8, 15, 16, 19-22 and 24-28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Heeger in view of Dodabalapur and in view of Hiroshi. Applicants respectfully traverse the rejection.

As Applicants have explained above, Heeger is disqualified as a reference against the application because the invention was conceived with due diligence to the actual reduction to practice before the effective date of Heeger.

Further, Applicants respectfully submit that the invention was conceived with due diligence to the actual reduction to practice before the effective date of Hiroshi. The earliest effective date of Hiroshi for the purposes of 35 U.S.C. §102(a) and §102(b) (and, therefore, 35 U.S.C. §103(a)) rejection is August 28, 2003, which is the publication date of the PCT application. See, MPEP §2136.03(II). However, the Muccini Declaration establishes that the invention was conceived with due diligence to the actual reduction to practice by February 3, 2003. Because February 3, 2003 is an earlier date than August 28, 2003, it is respectfully submitted that Hiroshi does not qualify as a 35 U.S.C. §103(a) reference in view of the Muccini Declaration.

There is nothing in Dodabalapur that would suggest or render obvious the subject matter recited in the claims at issue. In the absence of the primary Heeger reference, the rejection cannot stand.

Therefore, it is respectfully submitted that the rejection has been overcome and should be withdrawn.

Heeger in view of Dodabalapur, in view of Hiroshi and in view of Rogers

Claim 12 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Heeger in view of Dodabalapur, in view of Hiroshi and in view of Rogers. Applicants respectfully traverse the rejection.

As Applicants have explained above, Heeger and Hiroshi re disqualified as 35 U.S.C. §103(a) references. There is nothing in either Dodabalapur or Rogers that would render the subject matter of claim 12 obvious. In the absence of the primary Heeger reference, the rejection cannot stand.

Therefore, it is respectfully submitted that the rejection has been overcome and should be withdrawn.

Heeger in view of Dodabalapur, in view of Hiroshi, in view of Rogers and in view of Brazis

Claims 13 and 14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Heeger in view of Dodabalapur, in view of Hiroshi, in view of Rogers and in view of Brazis. Applicants respectfully traverse the rejection.

As Applicants have explained above, Heeger and Hiroshi do not qualify as 35 U.S.C. §103(a) references. There is nothing in Dodabalapur, Rogers or Brazis that would render the subject matter of claims 13 and 14 obvious. In the absence of the primary Heeger reference, the rejection cannot stand.

Therefore, it is respectfully submitted that the rejection has been overcome and should be withdrawn.

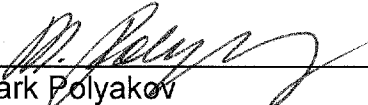
Conclusion

Applicants respectfully submit that the application is in condition for allowance. Accordingly, a Notice of Allowance is believed in order and is respectfully requested. Should the Examiner have any questions concerning the above, she is respectfully requested to contact the undersigned at the telephone number listed below. If the Examiner notes any matters which the Examiner

believes may be expedited by a telephone interview, the Examiner is requested to contact the undersigned.

If any additional fees are incurred as a result of the filing of this paper, authorization is given to charge Deposit Account No. 23-0785.

Respectfully submitted,



Mark Polyakov
Registration No. 57,344

Wood, Phillips, Katz, Clark & Mortimer
500 West Madison Street, Suite 3800
Chicago, Illinois 60661-4592
Telephone: (312) 876-2110
Facsimile: (312) 876-2020